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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,640	05/13/2008	Gregor Esser	100341.58126US	3282

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CROWELL & MORING LLP  
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EXAMINER
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STULTZ, JESSICA T

ART UNIT	PAPER NUMBER
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2873

MAIL DATE	DELIVERY MODE
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01/10/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,640	<b>Applicant(s)</b> ESSER ET AL.	
	<b>Examiner</b> JESSICA T. STULTZ	<b>Art Unit</b> 2873	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14, 16, 17, 20-25 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 16, 17, 20-23, 25 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/11/10</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14, 16-17, 20-23, 25, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by JP61023106 (translation filed with IDS 10/11/10), herein referred to as Hoya ‘106.

Regarding claim 14, Hoya ‘106 discloses a spectacle lens (Page 1, lens 1) having object-sided front face (3) and an eye-sided (2) rear face (Figure 1), wherein the rear face (2) comprises a viewing region (Pages 1-2) disposed thereon which contributes to the optical effect of the spectacle lens, and wherein the rear face further comprises a carrier rim region (chamfered portion 5) also disposed thereon which surrounds at least partially the viewing region and which does not significantly contribute to the optical effect of the spectacle lens (Pages 1-3), wherein the rear face in the carrier rim region is constructed substantially based on desired cosmetic properties, without consideration of optical image-forming properties (Pages 1-4, wherein the chamfered portion is formed to a shape for insertion into a frame for better comfort and look for the user), wherein the viewing region is separated from the carrier rim region (5) on the rear face of the spectacle lens by a dividing curve (6) that connects penetrating points of outermost peripheral rays to the rear face, said outermost peripheral rays just barely passing, under direct vision, through a point of rotation of the eye when the spectacle lens is in a use position in front

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of an eye (Pages 1-2 and 5, wherein the line 6 defines the separation between the vision section and the chamfered portion, which is placed in a frame and therefore the outermost visible rays are inherently along the line before the frame), and wherein further the rear face in the carrier rim region is constructed to consider: at least one of a frame shape and a frame design; and individual parameters of the spectacle wearer (Pages 1-2, wherein the chamfered region is formed for particular user lens frames).

Regarding claim 23, Hoya '106 discloses a method for producing a spectacle lens (page 1, lens 1) with an object-sided front face (3) and an eye-sided (2) rear face (Figure 1), wherein the spectacle lens comprises a viewing region (Pages 1-2) on the rear face that contributes to the optical effect of the spectacle lens, and wherein the spectacle lens further comprises a carrier rim region (chamfered portion 5) that is also on the rear face and that at least partially surrounds the viewing region and does not significantly contribute to the optical effect of the spectacle lens, comprising carrying out at least one of a calculation and optimization of the rear face in the carrier rim region carried out essentially based on desired cosmetic properties, without considering the optical image-forming properties of the carrier rim region (Pages 1-4, wherein the chamfered portion is formed to a shape for insertion into a frame for better comfort and look for the user), wherein the at least one of calculation and optimization comprises calculation of a dividing curve (6) on the rear face between the viewing region and the carrier rim region (5) in a curve shape that connects penetrating points of outermost peripheral rays to the rear face, said outermost peripheral rays just barely passing, under direct vision, through a point of rotation of the eye when the spectacle lens is in a use position in front of the eye of a spectacle wearer (Pages 1-2 and 5, wherein the line 6 defines the separation between the vision section and the

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chamfered portion, which is placed in a frame and therefore the outermost visible rays are inherently along the line before the frame), and wherein further the rear face in the carrier rim region is constructed to consider: at least one of a frame shape and a frame design; and individual parameters of the spectacle wearer (Pages 1-2, wherein the chamfered region is formed for particular user lens frames).

Regarding claims 16 and 25, Hoya '106 further discloses that the viewing region is separated from the carrier rim region (5) on the rear face of the spectacle lens by a dividing curve (6) that connects the penetrating points of outermost peripheral rays to the rear face, and said outermost peripheral rays just barely pass, under indirect vision, through the center of the entrance pupil of the eye (Pages 1-2 and 5, wherein the line 6 defines the separation between the vision section and the chamfered portion, which is placed in a frame and therefore the outermost visible rays are inherently along the line before the frame).

Regarding claim 17, Hoya '106 further discloses that the spectacle lens exhibits at least one of a positive, negative, progressive, astigmatic and prismatic optical power (Figure 1, the lens inherently exhibits negative power based on the shape of the lens).

Regarding claims 20 and 28, Hoya '106 further discloses that the rear face is designed so that the rear face of the carrier rim region is joined in a at least once, preferably in a twice continuously, differentiable manner to the rear face in the viewing region (Figure 1, wherein the lens comprises a continuous rear surface, Pages 2-3).

Regarding claim 21, Hoya '106 further discloses that the rear face in the carrier rim region is constructed to reduce at least one of an edge thickness, edge thickness variation and center thickness of the spectacle lens (Pages 1 and 5).

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Regarding claim 22, Hoya '106 further discloses that the rear face in the carrier rim region is configured to reduce volume and mass of the entire spectacle lens (Pages 1 and 5).

### **Response to Arguments**

Applicant's arguments with respect to claims 14, 16-17, 20-23, 25, and 28 have been considered but are moot in view of the new ground(s) of rejection as shown above.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA T. STULTZ whose telephone number is (571)272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica T Stultz  
Primary Examiner  
Art Unit 2873

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/Jessica T Stultz/

Primary Examiner, Art Unit 2873